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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,020

12/02/2003

Vito James Carlucci

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05/26/2005

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EXAMINER

GIBSON, RANDY W

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,020

Applicant(s)

CARLUCCI ET AL.

Examiner

Randy W. Gibson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-30 is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed May 5, 2005 have been fully considered but they are not persuasive. Applicant argues that the Artwick reference discloses a "cover" for a bathroom scale, not a "pad" for a bathroom scale. However, the examiner notes that the applicant has not given an express definition of "pad" in either the written description or the claim. See MPEP § 2111 *et seq.* Since the dictionary gives multiple definitions for the word "pad", the applicant cannot argue ordinary and customary meaning given by one of ordinary skill in the art since there is no such common definition. There is nothing in the claim which defines the critical structural details that distinguishes between a scale "pad" and a mere scale "cover". This argument is unpersuasive.

Applicant also argues that the Salini reference discloses only a scale "cover" made of "resilient foam", not a scale "pad". This argument is very confusing since the very first definition of "pad" given in the dictionary is "[a] thin, cushionlike mass of soft material used to fill, to give shape, or to protect against jarring, scraping, or other injury" (Dictionary dot com at <http://dictionary.reference.com/>, Lexico Publishing Group, LLC., Copyright © 2005.). It seems that the so-called "scale cover" of Salini squarely meet this express definition given in the dictionary. Applicant needs to provide more explanation.

Applicant also argues that Salini does not disclose "a pad display window corresponding in size and shape to the scale display window [emphasis in the original]." Applicant has provided no explanation why this intended use statement defines any

structural difference between his "window", and the opening 74 in the pad of Salini.

Applicant needs to provide more explanation.

Applicant argues that the mouse pad scale of the Gubitose does not have an operating system, controller or a memory. All of these features are contained in a PC which is separate from the scale and connected to it by a UBS cable. However, applicant has not pointed to any claim language which excludes an embodiment in which the scale and the controller are physically separate. Applicant needs to provide more explanation.

Applicant argues that the Levy reference does not compare weight information between two different individuals; rather Levy simply compares weight information from an individual with previous weight information taken for that particular individual. Levy might allow multiple users, but Levy does not compare weight information between different users. The examiner notes that the claim language does not specify that the weighing device must compare information between different users. The claim language simply specifies a weighing device that makes a comparison between different weight readings for "one" or more users. There is nothing in the claim language that requires the scale to make a comparison between weight readings taken from different users.

The applicant argues that the scale disclose in the Melton reference does not actually compare weight; this feature is carried out at a remote site. However, the applicant never pointed to specific claim language that requires that the scale itself provide the comparison, rather than at some remote site.

Applicant argues that the Tirkkonen reference does not disclose an “ergonomic body” sized and shaped for domestic use. However, the applicant has failed to explain why the bed is not a “body” within the broadest reasonable interpretation of the claim.

With regards to the rejection of claim 8, applicant argues that there is no motivation given in Artwick or any other reference to use a hypoallergenic, antibacterial, or antifungal material in the cover. The examiner notes that the motivation to combine does not have to be expressly stated in the references relied upon. See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 at 1276, 69 USPQ2d 1686 at 1690 (Fed. Cir. 2004). The applicant also seems to state that it is not technical feasible to modify the cover of Artwick in the manner suggested, but provides no explanation as to why not. Applicant makes similar arguments regarding the reference to Salini, and his arguments are unpersuasive for the same reasons. Applicant makes similar arguments regarding the 103 rejection of claim 13, and his arguments are unpersuasive for the same reasons.

In response to applicant's argument that the examiner's conclusion of obviousness regarding claim 13 is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant makes similar arguments regarding the various 103 rejections of claims 14, 16, and 20-23, and his arguments are unpersuasive for the same reasons. Furthermore, applicant's piecemeal analysis of the various references used are non-persuasive since one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant also argues that the pad of Artwick is "permanently fixed" to the scale and cannot be removed for washing. The examiner disagrees that Artwick discloses only an embodiment where the pad is permanently affixed. Applicant has provided no basis for his narrow reading of this reference.

Furthermore, it does not appear that applicant directly addressed any of the examiner's arguments made in any of the rejections.

2. Applicant's arguments regarding the Cary reference as applied to claims 25 and 27 are persuasive since applicant has amended claim 25 to overcome this reference. However, these arguments are now moot since there is now a new grounds of rejection regarding claims 25 and 27 in light of the reference to Kroll et al.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Artwick et al (US # 3,811,523). Artwick et al discloses the claimed invention including a housing (15) having a display window (Col. 4, lines 37-61) and a pad (20) overlaying the scale having a corresponding window (27), and the pad may be removable or secured to the housing (Col. 5, lines 43-64).

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Salini (US # 5,195,599). Salini discloses a foam pad (Col. 5, lines 42-48) for removably attaching to a scale (Col. 5, lines 49-59; Col. 10, lines 39-50) that also has a window cut into it (Col. 8, lines 44-48). Although not expressly stated, the examiner takes official notice that all modern supermarket scales have a display (for displaying price/weight), an input (cash register keyboard), and a memory. See *MPEP* § 2144.03. It is also noted that the window 74 is not for the express purpose of allowing one to see the display, but the examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, there appears to be no claimed structural difference.

6. Claims 9-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Gubitose (US # 6,426,471). Gubitose discloses an ergonomic scale (Col. 2, line 66-67;

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Col. 3, lines 30-58). Although not expressly stated, personal computer 30 inherently has a visual display, a microprocessor controller, a memory, a power source, and a keyboard input.

7. Claims 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Levy et al (US # 4,366,873). Levy et al discloses the claimed invention including a scale that interactively tracks weight information for multiple users (Abs.).

8. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Melton, Jr. (US # 6,038,465). Melton, Jr. discloses the claimed invention including a scale that automatically tracks weight information for multiple users (Abs.).

9. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tirkkonen (US # 3,722,611). Note that a bed is inherently ergonomic, and is also used domestically since every home has one.

10. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Kroll et al (US # 5,232,064). Kroll et al discloses a scale with supports (22) where the supports are movable relative to the scale (Col. 3, lines 52-59).



***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Artwick et al (US # 3,811,523). Artwick et al discloses the claimed invention except it does not expressly disclose that the cover is made from an antibacterial, antifungal, or hypoallergenic material. However antibacterial, antifungal, and hypoallergenic plastics are known, and since the surface of Artwick et al is intended to come into repeated contact with human skin, it would have been obvious to the ordinary practioner to include such a plastic to prevent the spread of disease or to prevent allergic reactions.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salini (US # 5,434,367). The pad of Salini is not expressly disclosed as having an antibacterial surface. However, antibacterial and antifungal plastics are known, and since the pad of Salini is supposed to come into contact with food, it would have been obvious to the ordinary practioner to include an antibacterial surface to prevent contaminating food.

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubitose (US # 6,426,471) in view of Miyahara et al (US # 4,764,981). Gubitose discloses the claimed device except for a remote control. Miyahara et al disclose that it is known to use a remote control to control a computer (Col. 1, lines 19-23). It would

have been obvious to modify the PC of Gubitose to include a remote control for the convenience of the user.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubitose (US # 6,426,471) in view of Nakano et al (US # 4,677,569). Gubitose discloses the claimed device except for voice activated commands. However, Nakano et al disclose that it is known to program a PC to respond to voice commands, so it would have been obvious to the ordinary practioner to modify the PC of Gubitose to accept voice commands for the convenience of the user.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubitose (US # 6,426,471) in view of Peoples (US # 4,876,805) or Weber et al (US # 5,121,962). Gubitose discloses the claimed device except for the use of a viscoelastic material in the pad. However, the use of viscoelastic foam for ergonomic purposes is known as show by the example of Peoples or Weber et al, so it would have been obvious to the ordinary practioner to use a known material in the ergonomic pad of Gubitose for its intended purpose.

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al in view of Artwick et al. Levy et al discloses the claimed invention except for the scale cover. Artwick et al discloses that it is know to provide a scale with a removable cover for decorative purposes; therefore it would have been obvious to place a cover on

the scale of Levy et al for the same purpose. The claimed limitations that the plastic cover provides more comfort than a bare steel weighing pan, and sanitary benefits also since it can be removed and washed, does not carry any patentable weight since it is claiming an inherent property of any plastic cover without defining any additional structure. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *MPEP* § 2112.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Melton, Jr. in view of Artwick et al. Melton, Jr. discloses the claimed invention except for the scale cover. Artwick et al discloses that it is know to provide a scale with a removable cover for decorative purposes; therefore it would have been obvious to place a cover on the scale of Melton, Jr. for the same purpose. The claimed limitations that the plastic cover provides more comfort than a bare steel weighing pan, and sanitary benefits also since it can be removed and washed, does not carry any patentable weight since it is claiming an inherent property of any plastic cover without defining any additional structure. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render

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the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *MPEP* § 2112.

19. Claims 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Meyer et al (US # 6,407,351) in view of Salini (US # 5,195,599). Note that the feet of Meyer et al are vertically adjustable. It is unclear if the term "ergonomic" is a structural limitation, but if it is, then Salini discloses that it is known and obvious to place a pad on a food scale, such as the food scale of Meyer et al, to prevent produce from being bruised.

Such a pad would be inherently "ergonomic" since it seems to have the same structure as applicant's disclosed pad. As far as the limitation of being "sized and shaped for domestic use", the scale of Meyer et al seems to be approximately the same "size" and "shape" as applicant's scale; even if not, it seems self-evident that the scale of Meyer et al is inherently useful in a household kitchen. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *MPEP* § 2112.

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20. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll et al (US # 5,232,064) in view of Provi (US # 4,082,153). As discussed above, Kroll discloses the claimed invention, except Kroll does not have a way of activating the scale by tapping on it in a certain location. However, Provi disclose that it is known to activate a scale by means of a kick bar. It would have been obvious to the ordinary practioner to include a kick bar with the scale of Kroll et al for the convenience of the user.

### ***Conclusion***

21. Claims 28-30 are allowable over the art of record. Oldendorf et al (US # 4,848,477) disclose a method of repositioning a calibration weight in response to indicators on a display that follow a pre-programmed calibration routine, and Sela (US # 5,058,691) use IR beams to detect whether an object is fully on a supermarket scale or not, but there is no teaching in the art of record to modify a scale that weighs a "user" (a whole person) to indicate to the user how to position himself on the scale.

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

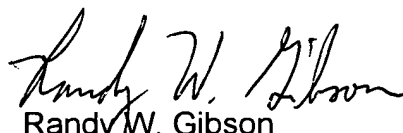
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (571) 272-2103. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Randy W. Gibson  
Primary Examiner  
Art Unit 2841